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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/023,245
Filing Date: December 18, 2001
Appellant(s): BERNIER ET AL.

Wendy A. Choi
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 11, 2007 appealing from the Office action mailed July 11, 2007

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20020078160 KEMP June 2002

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20020113994 SMITH August 2002

20020100801 SEHR August 2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 13-18, 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kemp et al US PUB (20020078160) in view of Smith, II et al. US. Publication 20020113994, hereinafter "Smith".

As per claim 1, Kemp et al teach a method of providing a service and generating (providing print service), at the location of a remote printer, a permanent record of said service, wherein, before generating the permanent record, data necessary to provide said service and data necessary to provide said permanent record are processed by at least one remote server operated by

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a service provider (service provider 2, fig. 1) (abstract and fig. 1), said method comprising the steps:

(A) receiving over data communication network (Internet 5, fig. 1) at remote service provider receiving center (fig. 1, 2), from a user operated communications device (fig. 1, 1), a request for the service and said data necessary to provide the service (receiving a request for data to be printed at service provider ¶ 0035; ¶ 0054-0056 and ¶ 0067-0070) including user provided data identifying and specifying a remote printer and data regarding how to address and access said remote printer over a data communications network (user selects remote printer from a list of favorite service providers and choose the provider address and type of printer to perform the service (fig. 5, S116 and fig. 6B, 63), User provides search criteria for accessing service provider ¶ 0057-0062), said receiving center comprising at least one service provider operated remote server (service provider 2, fig. 1 operated remote server 20); said data necessary to provide the service being processed to generate data required for the service (¶ 0035-0042);

(B) processing on said service provider operated remote server said data required for the service and other stored data to generate input data for a remote printer (fig. 5, S116 and fig. 6B, 63 ¶ 0037-0041; 0073 and ¶ 0084-0087);

(C) transmitting by said service provider over a data communication network (Internet 5) to said specific remote printer said input data (print data

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is submitted over the Internet to a selected remote printer at a remote service provider, fig. 1 ¶ 0020-0023), said input being rendered by the remote printer as the permanent record of said service (¶ 0038-0042; ¶ 0048-0053 and ¶ 0069-0070. see also ¶ 0081-0087).

Although Kemp shows substantial features of the claimed invention including “service provider server 20 could be setup to automatically process the print job data upon receipt and manual operator intervention would not be required” (¶ 0073 and fig. 5, S116 and fig. 6B, 63), he does not explicitly show user chosen and designated specific remote printer. Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Kemp, as evidenced by Smith USPN. (20020113994).

In analogous art, Smith whose invention is about printing portable-selected information, disclose “a portable device prints using a printer by transferring print information to the printer via the Web. The portable device makes wireless connection with the Web (network 103) via an internet service provider (ISP) 117 to transfer information to user equipment 113 for printing on the printer 115. This information can include truncated information to be directly printed on printer 115, and can include one or more references to a content rich full-information set residing on or accessible to the equipment 113 [¶ 0033; see fig.1 and fig. 7D]. Giving the teaching of Smith, a person of ordinary skill in the art would have readily recognized the desirability and the advantage

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of modifying Kemp by employing the system of Smith to allow a user to access versatile printing options that allow any time and anywhere printing of desired information.

As per claim 2, Kemp et al teach the method of Claim 1 wherein the receiving center comprises a receiving server (fig. 1, server 20).

As per claim 3, Kemp et al teach the method of Claim 2 wherein step (B) farther comprises the steps providing said data required for the service to a printing server (§ 0035-0037); and generating the input data for a specific printer at the printing server (§ 0070-0071 and § 0085).

As per claim 4, Kemp et al teach the method of Claim 1 wherein step (B) further comprises:

completing a transaction at a transaction server, said transaction depending on the requested service, said transaction server being one of said remote servers (fig. 1 and § 0056).

As per claim 5, Kemp et al teach the method of Claim 2 wherein step (B) further comprises:

completing a transaction at a transaction server, said transaction depending on the requested service, said transaction server being one of said remote servers (fig. 1 and ¶ 0056).

As per claim 6, Kemp et al teach the method of Claim 1 further comprising the step of:

sending, after step (B) a message confirming that the request for service has been fulfilled (¶ 0066).

As per claim 7, Kemp et al teach the method of Claim 2 further comprising the step of:

sending, after step (B) a message confirming that the request for service has been fulfilled (¶ 0066).

As per claim 8, Kemp et al teach the method of Claim 1 wherein step (B) further comprises:

processing the data for the service and other data to generate input data to produce the optimal quality print for a specific printer (¶ 0041, ¶ 0070-0071 and ¶ 0085).

As per claim 9, Kemp et al teach the method of Claim 2 wherein the receiving server is a printing Server (fig. 1, server 20).

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As per claim 10, Kemp et al teach the method of Claim 2 wherein the receiving server is a service server (fig. 1, server 20 and ¶ 0039).

As per claim 13, Kemp et al teach the system of Claim 15 wherein the requested service is an image (¶ 0036-0038).

As per claim 14, Kemp et al teach the method of Claim 1, wherein the requested service is a compound document (¶ 0036-0039).

Regarding claim 15, this is a system claim with similar limitations as claim 1 above. Therefore, it is rejected with the same rationale.

As per claim 16, Kemp et al teach the system of Claim 15 further comprising:

means for completing a transaction at a transaction server, said transaction depending on the requested service, said transaction server being one of said remote servers (fig. 1 and ¶ 0056).

As per claim 17, Kemp et al teach the system of Claim 15 further comprising:

means for sending, after processing the data required for the service, a message confirming that the request for service has been fulfilled (¶ 0066).

As per claim 18, Kemp et al teach the system of Claim 15 further comprising:

means for processing the data for the service and other data to generate input data to produce the optimal quality print for a specific printer (§ 0041, § 0070-0071 and § 0085).

As per claim 21, Kemp et al teach the system of Claim 15 wherein the requested service is an image (§ 0036-0038).

As per claim 22, Kemp et al teach the system of Claim 15 wherein the requested service is a compound document (§ 0036-0039).

As per claim 23, Kemp et al teach the system of Claim 15 wherein the receiving center comprises a receiving server (fig. 1, server 20 and § 0038-0042).

As per claim 24, Kemp as modified by Smith teach the system of Claim 15 further comprising:

means for providing said data required for the service to a printing server (fig. 1, server 20 and § 0039); and

means for generating the input data for a specific printer at the printing server (fig. 5, S116 and fig. 6B, 63 § 0038-0042 § 0073).

Claims 11-12 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kemp et al US PUB (20020078160) in view of Smith and further in view of Sehr US. Pub. (20020100802).

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Regarding claim 11 and 19, although Kemp et al and Smith show substantial features of the claimed invention, they do not explicitly show wherein the requested service is an event ticket.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Kemp et al and Smith, as evidenced by Sehr US Pub. (20020100802).

In analogous art, Sehr whose invention is about services offered by service providers at remote locations, such as advanced ticket purchasing stations, automated vending machines, travel agencies and entertainment entities, or providers of on-line services to traveling individuals, discloses providing an event ticket service [¶ 0029 and 0054]. Giving the teaching of Sehr, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Kemp et al and Smith by employing the system of Sehr because this will improve quality of service offered to customers using ticket dependant events to participate the event with a minimal delay.

As per claim 12 and 20, Sehr teaches the method of Claim 1 and 15, wherein the requested service is a coupon [redeemable points in a card ¶00 47 and 0053].

(10) Response to Argument

In essence the Appellant seems to argue the following points:

1-The Appellant argues “that Kemp does not disclose, teach, or suggest the use of a user chosen and designated printer and, thus, the second data type.” (Page 7, second paragraph).

2- “Kemp does not mention of a permanent record of this printing service that is transmitted to remote printer and that is chosen by the user.” Page 8 first paragraph.

3- “Indeed Kemp is quite clear that in that invention the ‘print job is not being submitted directly to a specific printer, but rather is being submitted directly to a server in a service provider 2, ...” and that “Kemp actually teaches away from the subject matter of claim 1...” page 8 second paragraph and page 10 end of second paragraph.

4-“Kemp and Smith are not simply combinable in the manner needed to arrive at the subject matter of claim 1.” Page 8 end of first paragraph.

- Response to point number 1:

In response to Appellant's arguments against the references individually (**“that Kemp does not disclose, teach, or suggest the use of a user chosen and designated printer...”**), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of

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references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this regard Kemp is not relied upon to teach this limitation as shown in the final office action, instead Smith teaches the limitation **of a user chosen and designated printer**. As shown in the office action, Smith disclose “a portable device prints using a printer by transferring print information to the printer via the Web. The portable device makes wireless connection with the Web (network 103) via an internet service provider (ISP) 117 to transfer information to user equipment 113 for printing on the printer 115. This information can include truncated information to be directly printed on printer 115, and can include one or more references to a content rich full-information set residing on or accessible to the equipment 113 [¶ 0033; see fig.1 and fig. 7D]. See also ¶ 0023 “As specified in the user's profile in memory 125, the high capacity presentation apparatus includes the printer 115. The full length press release is formatted for the printer by the server 101 and sent to the printer for a hard copy print of the press release to be created.” Therefore, Smith clearly teaches the argued limitation.

- Response to point number 2:

Examiner notes that Kemp teaches “print driver 282 submits a job ticket that includes the user's information (including payment type), type of print job to be

printed (black and white, color or photo, finishing options, etc.), and number of pages contained in the print job, to service provider server 20.” (§ 0069).

“Upon receiving the job ticket and payment information 50 from print driver 282, service provider server 20 processes the job ticket to generate a job identification number and a cost of processing the job...If service provider server 20 determines that service provider 2 is able to fulfill the job ticket, then the server calculates a cost, and perhaps even an estimated completion date, based on the job ticket information and generates a job identification number for the job ticket. Service provider server 20 then responds to the job ticket with the cost and job ID information 51 and submits this information via Internet 5 to print driver 282” (§ 0070). Therefore, Kemp clearly teaches generating a job ticket that includes service transaction related information such as cost and payment information. Once the user confirms/approves the job, the job ticket is submitted to the print driver (see also § 0054, 0056 and § 0081-0082).

- Response to point number 3 and 4.

As explained above, Smith is only relied upon to show printing a data (full length of desired information) at a user chosen and designated specific remote printer (§ 0023 and §0031-0034). Contrary to Appellants argument that Kemp teaches away from the subject matter of claim 1 (see page 8, second

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paragraph), Examiner believes that Kemp and Smith complement each other to arrive at the whole teaching of the Appellants invention. Kemp and Smith are about remote printing of a print data such as (a job ticket or hard copy of stock quotation information (permanent record)) to be printed at a remoter printer location similar to Appellant's invention. Furthermore, Smith is more specific about selecting which particular printer data is to be sent. Therefore, the combined teachings of Kemp and Smith arrive at subject matter of claim 1 and 15 as argued.

In regard to claim 15, the Appellant seems arguing about generating a permanent record at a user chosen and designated remote printer. **“The system of claim 15 must generate at the location of a user chosen and designated remote printer a permanent record of a service.” Page 10, last paragraph.**

The examiner maintains the combined teaching of Kemp and Smith clearly render the subject matter of claim 15 for the same reasons set forth above in regard to claim 1.

Finally, in response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (page 10, third paragraph), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

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long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case the Examiner has shown clearly how one of ordinary skill in the art at the time the claimed invention was made would arrive at the subject matter claimed by combining the teachings of Kemp and Smith.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Yasin M Barqadle/

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Art Unit: 2100

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